



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

✓.0

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/891,301	07/10/97	HARRENSTIEN	K 224/183

022249  
LYON AND LYON LLP  
SUITE 4700  
633 WEST FIFTH STREET  
LOS ANGELES CA 90071-2066

LM01/1026

EXAMINER

TRAN, P

ART UNIT

PAPER NUMBER

2749

DATE MAILED: 10/26/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/891,301

Applicant(s)  
Harrenstien et al.

Examiner  
Pablo Tran

Group Art Unit  
2746



☒ Responsive to communication(s) filed on Aug 16, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) 9 and 13-15 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8, 10-12, and 16-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2746

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-7, 10-12, 16-20, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by *Hidary* (U.S. patent 5,852,775).

As per claim 1, *Hidary* disclose a method for transmitting information from a server to a client station in a mobile-based client-server system, comprising the steps of:

- determining that the server has information to be transmitted to a client station (fig. 1, abstract); and
- transmitting a message from a transceiver associated with the server to a transceiver associated with the client station, the message indicating that the server has information for the client station (fig. 1, col. 2/lines 63-67, and col. 3/lines 1-3).

Art Unit: 2746

As per claim 2, *Hidary* further disclose establishing a connection between the client station and server in response to a received message (fig. 1, col. 2/lines 63-67, and col. 3/lines 1-3).

As per claim 3, *Hidary* further disclose wherein the connection between the client station and server is established via the respective client station and server transceivers (fig. 1, col. 2/lines 63-67, and col. 3/lines 1-3).

As per claim 4, *Hidary* further disclose wherein the message indicates the type of information to be transmitted to the client station (abstract).

As per claim 5, *Hidary* further disclose evaluating a received message at the client station to determine whether the information is of a selected type (fig. 1, col. 2/lines 63-67, col. 3/lines 1-3 and 62-67, and col. 4/lines 1-3).

As per claim 6, *Hidary* further disclose wherein the message indicates the quantity of information to be transmitted to the client station (col. 3/lines 39-50).

As per claim 7, *Hidary* further disclose wherein the respective client station and server transceivers are GSM-based transceivers (fig. 1).

As per claims 10 and 24-25, *Hidary* further disclose a method for transmitting information from a server to a client station in a mobile-based client-server system, comprising:

- evaluating the information at the server to determine whether the information is of a selected type and quantity (fig. 1, abstract, and col. 3/lines 24-28); and

Art Unit: 2746

- transmitting a message from a transceiver associated with the server to a transceiver associated with the client station if the information is of a selected type and quantity, the message indicating the server has information for the client station (fig. 1, col. 2/lines 63-67, and col. 3/lines 1-3).

As per claim 11, 12, and 20, *Hidary* further disclose comprising the further steps of:

- evaluating a received message at the client station to determine whether the information is of a selected type/quantity (fig. 1, abstract, and col. 3/lines 24-28); and
- establishing a connection between the client station and server in response to a received message if the information is of a selected type/quantity (fig. 1, col. 2/lines 63-67, and col. 3/lines 1-3).

As per claims 22-23, *Hidary* further disclose whether the information is of a type/quantity requiring that the client station be notified (col. 2/lines 63-67, col. 3/lines 1-3, and col. 3/lines 24-28);

As per claim 16, *Hidary* further disclose a machine readable medium having stored thereon a program for adapting a client station to receive and process messages transmitted from a server via a wireless network connection, and for causing the client station to perform the steps of:

- evaluating a received message to determine whether the server has a selected type and quantity of information waiting for the client station (col. 3/lines 24-28 and 38-50);

Art Unit: 2746

- generating a signal containing a telephonic address of a communication transceiver associated with the server and instructions for establishing a log-on connection with the server if the server has a selected type and quantity of information waiting for the client station (col. 2/lines 63-67, col. 3/lines 1-3, and col. 3/lines 24-28 and 38-50);; and

- transmitting the signal to a transceiver associated with the client station, the client station transceiver configured to establish a communication link with the server transceiver based on the telephonic address (fig. 1, fig. 2, abstract and col. 2/lines 23-34)..

As per claim 17, *Hidary* further disclose the stored program causing the client station to perform the additional steps of:

- transmitting a first request for the information to the server via the established communication link (col. 2/lines 63-67, col. 3/lines 1-3);
- receiving the requested information (col. 2/lines 63-67, col. 3/lines 1-3); and
- transmitting additional information to the server via the established communication link (col. 2/lines 63-67, col. 3/lines 1-50);.

As per claim 18, *Hidary* further disclose wherein the additional information comprises a further data request (col. 4/lines 26-36).

As per claim 19, *Hidary* further disclose a mobile-based client-server system, comprising:

- a client station adapted for communication with an associated client station transceiver (fig. 1); and

Art Unit: 2746

- a server configured to periodically receive or generate information to be delivered to the client station, the server linked to an associated server transceiver (fig. 1, abstract, and col. 1/lines 44-64), wherein

- the server is further configured to transmit a message to the client station via the respective server and client station transceivers upon receiving or generating a selected threshold of information to be delivered to the client station (fig. 1, fig. 2).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hidary* (U.S. patent 5,852,775).

As per claim 8 and 21, *Hidary* disclosed Applicant's invention except for teaching wherein the server transceiver sends the message to the client station transceiver in the form of an SMS paging message. It would have been useful to provide an SMS paging message to provide automatic answer transmission. However, such is notoriously well-known in the art the Examiner takes official notice of such. Therefore, it would have been obvious to one of ordinary skill in the

Art Unit: 2746

art at the time of Applicant's invention to utilize the method of SMS paging message, well-known in the art, in conjunction with a cellular telephone Messaging system as taught by *Hidary*.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

*Tett* (5,635,918), *Davis* (5,845,202), *Cannon et al.* (5,850,594), *Lahtinen* (5,351,235), *Pepe et al.* (5,742,668) discloses method and apparatus for controlling message delivery to wireless system.

*Roach, Jr.* (5,845,211), *Harrison et al.* (5,796,727), *Grimes et al.* (5,463,623) disclose integrated wireless telecommunication and local area network system.

*Thro et al.* (5,884,159) disclose method of spawning a communication service.

### ***Response to Amendment***

6. Applicant's arguments filed June 1, 1999 have been fully considered but they are not persuasive.

In response to the Applicant's arguments, the Applicant's stated that "determining that the server has information to be transmitted to the client station and evaluating information at the server to determine whether the information is of selected type and quatity" is not anticipated by *Hidary*"



Art Unit: 2746

As per claim 1, 10, 16 and 19, *Hidary* disclose an ad server that target specific subscriber. Based on the subscriber profile, the ad server evaluated the information and determined that the server has information to be transmitted to the client station (col. 3/ln 4-29).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Any response to this final action should be mailed to:**

**Box AF**

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**or faxed to:**

**(703) 308-9051, (for formal communications; please mark  
"EXPEDITED PROCEDURE")**

**Or:**

**(703) 308-9508, (for informal or draft communication, please  
label "PROPOSED" or "DRAFT")**

**Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).**

Art Unit: 2746


7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. The fax number for this Group is (703)305-9508.

Any inquiry of a general nature to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-3900.

October 25, 1999

Pablo Tran

Examiner, Art Unit 2746

  
EDWARD F. URBAN  
PRIMARY EXAMINER